

REMARKS

Claims 1-16 are pending in the present application after this amendment adds new claims 14-16. No new matter is added by the new claims, which find support throughout the specification and figures. In particular, support for new claims 14-16 is in the specification at page 14, lines 10-20, and specifically at lines 13-16. In view of the amendments and the following remarks, favorable reconsideration of this case is respectfully requested.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,154,729 to Cannon et al. (hereinafter referred to as Cannon), in view of United States Publication No. 2001/0047326 A1 to Broadbent et al. (hereinafter referred to as Broadbent). Applicants respectfully traverse.

The Examiner admits that Cannon does not disclose the server being an Application Server Provider (ASP). (Office Action; page 3, lines 3-4). The Examiner asserts that Broadbent discloses this feature, and asserts that the motivation to combine the references is that "ASP servers are a popular business model with regards (sic) to servers and communication systems." (Office Action; page 3, lines 7-8). However, this broad, unsupported, statement relating to the popularity of ASP servers does not provide a motivation to combine the ASP server allegedly disclosed in Broadbent, with the system disclosed in Cannon. This motivation to combine appears to be the result of hindsight reasoning, and therefore the combination of references is improper.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis

added). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in Teleflex, Inc. et al. v. KSR Int’l Co., (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, “a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, ***but some motivation to combine the prior art teachings in the particular manner claimed.***” (*Teleflex*, citing *In re Kotzab*; emphasis added). The Federal Circuit found that that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the ***test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.***

(*Teleflex*, citing as background *Rouffet*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Broadbent to combine its teaching with

Cannon, or vice versa. As the *Teleflex* court held, there must be *specific teaching* to motivate a person of ordinary skill in the art must to combine the prior art teachings *in the particular manner claimed*. Therefore, the combination of the references is improper and the result of hindsight reasoning, and the rejection of claim 1 should be withdrawn.

Each of the claims is rejected based on the combination of Cannon and Broadbent, and therefore, since the combination is improper, as discussed above due to the lack of motivation to combine the references, the references do not render the claims unpatentable.

Additionally, the combination of Cannon and Broadbent does not disclose all of the features of claim 1. Claim 1 relates to an examination method that includes, *inter alia*, *storing information on business activities of an enterprise on an ASP (Application Service Provider) server from a terminal of said enterprise through a network*, and *providing said information on business activities of said enterprise accumulated on said ASP server for an examiner*. The method of claim 1 also includes evaluating activities of said enterprise based on said information on business activities provided for said examiner.

Cannon apparently discloses a service in which the transaction history of the merchant is recorded in a bank database. In other words, Cannon apparently discloses only a basic implementation of outsourcing. Broadbent apparently discloses a system in which a borrower collects loan conditions from a plurality of banks or financial institutions based on the borrower's condition and selects most suitable lender. Broadbent states that this system may be implemented as an ASP. However, Broadbent apparently relates to a user collecting information from various banks, whereas the present application relates to storing information about business activities on an ASP. Neither Cannon nor Broadbent discloses storing information on business activities of an enterprise on an ASP (Application Service Provider) server from a terminal of

said enterprise through a network, nor does either reference disclose or suggest providing said information on business activities of said enterprise accumulated on said ASP server for an examiner.

The present invention discusses a financial institution or bank setting up and operating an ASP server to undertake the database management of finance, accounts, marketing, manufacturing, and the like of the client company. Additionally, the method of claim 1 discusses performing a loan examination based on information on business activities of the client company accumulated on the ASP server. Since the financial institution keeps the information on business activities of the company, the financial institution can “enclose” the company as a client. The financial institution using such an invention has an advantage over competitors and can estimate the most reasonable loan condition. Since the financial institution receives such benefit from the present invention, it can provide the client company with the ASP service at a low cost or even at no charge. Therefore, the client company can also receive benefit from the present invention.

It is respectfully submitted that neither of the references disclose or suggest storing information on business activities of an enterprise on an ASP (Application Service Provider) server from a terminal of the enterprise through a network, or providing the information on business activities of the enterprise accumulated on the ASP server for an examiner. Therefore, for at least this additional reason, claim 1 is allowable.

Each of the other independent claims includes features similar to those discussed above in regard to claim 1, and therefore each of the independent claims is allowable for the same reasons as claim 1 is allowable. Each of the dependent claims is allowable for at least the same reasons as their respective base claims are allowable.

New claims 14-16 ultimately depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable. Additionally, claim 14 recites that the ASP limits access to update the stored information of the enterprise to the terminal of the enterprise. It is respectfully submitted that none of the cited references disclose or suggest this feature, and therefore for at least this additional reason, claim 14 is allowable.

New claim 15 depends from claim 14 and recites that the terminal obtains access to the stored information by communicating an authorization code to the ASP, and that the authorization code is provided by the ASP and associated with the enterprise by the ASP. It is respectfully submitted that none of the cited references disclose or suggest this feature, and therefore for at least this additional reason, claim 15 is allowable.

New claim 16 recites that the ASP provides access to the stored information of the enterprise to assist the examiner to evaluate activities of the enterprise. It is respectfully submitted that none of the cited references disclose or suggest this feature, and therefore for at least this additional reason, claim 16 is allowable.

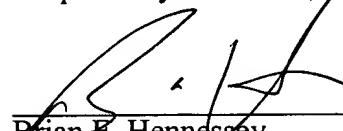
CONCLUSION

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

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Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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